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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/117,071 09/25/98 KINGSMAN

A 9192.5USWO

HM12/1215  
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EXAMINER

LEE, G  
ART UNIT

PAPER NUMBER

1632  
DATE MAILED:

12/15/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/117,071

Applicant(s)

Kingsman et al.

Examiner

Gai (Jennifer) Mi Lee

Group Art Unit

1632



Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 22-46 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 22-46 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Internal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 22-25, 31-34, 41, 42-44, 45, 46 are drawn to in vivo method of making vector, in vivo producer cell, use of DNA for gene therapy medicament, method of making producer cell in vivo, gene therapy, classified in class 514, subclass 44.
  - II. Claims 26-34, 36-39 are drawn to DNA, isolated producer cell, in vitro method of making producer cell, classified in class , subclass .
  - III. Claims 35, 40 are drawn to producer cell for re-implantation, use of cell for gene therapy medicament, classified in class , subclass .

Claims 31-34 are generic to groups I-II. Should either one of groups I or II be elected,

claims 31-34 will be examined on the merits and in conjunction with the elected claims.

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2. The inventions are distinct, each from the other because of the following reasons:

Invention I and II are drawn to distinct products capable of separate use. The DNA of invention I can be used as a probe in hybridization assays and the producer cell of group II can be used to produce antibodies.

Invention I and III are drawn to mutually exclusive and independent methods. Invention I is to an in vitro method of making producer cells. Invention III is to an in vivo method of treatment. The in vitro and in vivo methods require separate and distinct protocols. Neither invention I or III is required for implementation of the other invention.

Invention II and III are drawn to mutually exclusive and independent methods. Invention II is to an ex vivo method of gene therapy treatment. Invention III is to an in vivo method of gene therapy treatment. The ex vivo and in vivo methods require separate and distinct protocols. Neither invention II or III is required for implementation of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is not strictly (CFR 1.143).

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gai (Jennifer) Mi Lee whose telephone is (703)306-5881. The examiner can normally be reached on Monday-Thursday from 9:00 to 5:30 (Eastern time). The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The FAX phone numbers for group 1600 are (703)308-4242 and (703)305-3014.

An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703)308-0196.

**Gai (Jennifer) Mi Lee**  
Patent Examiner  
Group 1600

*Deborah Crouch*  
DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1600